

## REMARKS

### Amendments to the Drawings:

The Examiner objected to the drawings for not being placed in consecutive order (figure 6 appears before figure 4). The Examiner requested that corrected drawing sheets in compliance with 37 CFR 1.121(d) be submitted with the response to the Office Action.

Applicants have included in their response, amended replacement drawings placed in consecutive order and labeled in the top margin "Replacement Sheet" as required by 37 CFR 1.121(d). Applicants, therefore, respectfully request that the Examiner withdraw his objection to the drawings.

### Amendments to the Specification:

#### A. Abstract

The Examiner has objected to the abstract of the disclosure for being drawn to inventions for identifying medical literature using disease classification systems and genetic profiles, while the elected invention is solely drawn for using genetic profiles.

Applicants have canceled the claims drawn on the use of genetic profiles and instead have added new claims. Since the abstract is now amended to reflect these changes, Applicants respectfully request that the Examiner withdraw his objection to the abstract.

#### B. Informal Usage of Registered Marks

The Examiner has objected to the informal usage of registered marks in the specification. More specifically, the Examiner noted that the term MEDLINE, appeared in the specification without all the letters capitalized and without the trademark symbol.

Applicants have thoroughly searched the specification and amended the usage of all registered marks. Therefore, Applicants respectfully request that the Examiner withdraw his objection to the informal usage of registered marks in the specification.

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**Amendments to the Drawings:**

Please replace the drawings with the attached replacement sheets and annotated sheets showing changes.

Attachments: Replacement Sheets  
Annotated Sheets

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Prior to Applicants' response to this Office Action, claims 1-103 were pending with claims 1-51, 61-63, 65-71, 76, 78-80, 101 and 102 withdrawn from consideration. Claims 52-60, 64, 72-75, 77, 81-100, and 103 were rejected. Applicants have canceled claims 52-103 and added new claims 104-127, so that claims 1-51 and 104-127 are now pending.

Applicants' counsel thank the Examiner for extending the courtesy of holding a telephonic interview on July 11, 2007 wherein the Office Action and proposed new claims were discussed.

Reconsideration of the application in view of the amendment and remarks is respectfully requested.

#### I. **Newly Presented Claims**

Applicants have presented new claims 104-127. No new matter is added herein. Support for the newly added claims is found in the entire specification and more specifically as noted below. Support for the phrase "searching a medical literature database using a medical literature classification system identifier" in claims 104 and 124 is found in paragraphs 0004, 0005, 0022, and 0072. Support for the phrase "for a disease" is implicitly found in the specification as the intent of the invention is to provide practicing clinicians with current, relevant medical information as mentioned in paragraphs 0002, 0014-0018, 0052, and 0053. Further, diseases comprise a subset of the citations found in a medical literature database. Additionally, diseases are the individual subunits of a disease classification system such as the ones mentioned in paragraphs 0019 and 0027. Support for "evidence based medicine search filter" is found in paragraphs 0004, 0019, 0056-0061 and Table 1. Support for "integrat[ing]" the search of a medical literature database with an evidence based medicine search filter is found in paragraphs 0004, 0019, 0052, 0069, and 0070, and in Figure 4. Support for the phrase "searching a database of articles selected and reviewed by experts" is found in paragraphs 0017 and 0076. Support for the phrase "displaying the results" is found in paragraphs 0023, 0072, and 0073, and Figures 2 and 5.

Support for claims 105-113, 125, and 126 can be found in the claims as originally filed and in paragraphs 0029 and 0030. Support regarding claims 114-117, and 127 can be found in the claims as originally filed, in paragraphs 0058-0061 and in Table 1. Support concerning claim 118

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can be found in paragraphs 0067 and 0069. Support for claim 119 can be found in paragraph 0070. Support regarding claim 120 can be found in paragraph 0068. Support for claims 121 and 122 can be found in the claims as originally filed. Support for claim 123 can be found in paragraph 0023 and in Figure 2.

Applicants believe a new search by the Examiner is not warranted as the previous independent claims 52 and 103 incorporated the steps of using one or more medical identifiers to search a medical literature database in conjunction with an evidence-based medicine search string. Additionally, genetic profiles of diseases are equivalent to medical literature classification system identifiers for disease once the genetic profiles are translated into medical literature classification system identifiers.

## II. Claim Rejections – 35 USC § 101

### A. Claims 52-60, 64, 72-74, 77, 81-100, and 103, Tangible Result

The Examiner rejected claims 52-60, 64, 72-74, 77, 81-100, and 103 under 35 U.S.C. §101 because the claimed invention was allegedly directed to non-statutory subject matter. More specifically, the Examiner asserted that the claimed invention does not produce a tangible result.

The rejected claims are now canceled. Further, Applicants' new claims meet 35 U.S.C. §101 as they produce a tangible result by displaying the results of the searches to the user. Therefore, Applicants respectfully request that the Examiner withdraw his objection.

### B. Claim 103, Non-functional Descriptive Material

The Examiner further rejected claim 103 for the use of the phrase "code implementing a method" that the Examiner alleged to be unclear and therefore, was interpreted as non-functional descriptive material.

Claim 103 is now canceled. Further, Applicants' new claim states, in part, "a computer readable medium comprising code implementing a method" that Applicants assert is functionally descriptive material. Applicants, therefore, respectfully request that the Examiner withdraw his rejection of claim 103.

### **III. Claim Rejections – 35 USC § 112**

#### **A. Rejection of Claims 52-60, 64, 72-75, 77, 81-100, and 103 under 35 U.S.C. 112, First Paragraph**

The Examiner rejected claims 52-60, 64, 72-75, 77, 81-100, and 103 under 35 U.S.C. 112, first paragraph, for allegedly not being sufficiently enabling for the claimed invention. More specifically, the Examiner asserted that the Applicants provided little guidance as to how to carry out the translation of genetic profiles to identifiers for a medical literature classification system.

The rejected claims are now canceled. Additionally, Applicants' new claims do not perform this step. Appellants, therefore, respectfully request that the Examiner withdraw his rejection to these claims.

#### **B. Rejection of Claims 52-60, 64, 72-75, 77, 81-100, and 103 under 35 U.S.C. 112, Second Paragraph**

The Examiner rejected claims 52-60, 64, 72-75, 77, 81-100, and 103 under 35 U.S.C. 112, second paragraph, for allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. More specifically, the Examiner asserts it is unclear how the step of "filtering the medical literature database based at least on relevance to evidence-based medicine" is related to the rest of the method. Additionally, the Examiner asserts that that it is unclear what purpose the filtering step serves.

The rejected claims are now canceled. Further, Applicants' new claims are directed to searching a medical literature database in an integrated way using a medical literature classification system identifier for a disease together with an evidence based search filter. The results of the combined search are displayed to the user. Applicants, therefore, respectfully request that the Examiner withdraw his rejection.

### **IV. Claim Rejections – 35 USC § 102**

The Examiner rejected claims 52-58, 72-75, 77, 100, and 103 under 35 U.S.C. 102(b) for allegedly being anticipated by Rappaport (U.S. Publication # 2002/0007285) published January 17<sup>th</sup>, 2002.

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Applicants have canceled the rejected claims. Rappaport did not anticipate the claims as presented. In order to anticipate an invention, a reference must have disclosed every element of the invention. Applicants' new claims include the following element: "searching a database of articles selected and reviewed by experts that concern the disease". Rappaport did not disclose this element. Therefore, Rappaport did not anticipate the claims. Hence, Applicants respectfully request that the Examiner withdraw his rejection.

**V. Claim Rejections – 35 USC § 103**

The Examiner rejected claims 59-60 under 35 U.S.C. 103(a) for allegedly being unpatentable over Rappaport (U.S. Publication # 2002/0007285) as applied to claims 52-58, 72-75, 77, 100, and 103 above, and further in view of Davies et al. (U.S. Patent Publication #2003/0046114) filed October 23<sup>rd</sup>, 2001.

Applicants have canceled the rejected claims. A combination of references cannot have made an invention obvious if the combination did not disclose every element of the claims. As Applicants discusses above, the primary reference, Rappaport, did not disclose an element of the invention. Davies did not supply the missing element. Therefore, the combination of references did not disclose every element of the invention or render the invention obvious. Therefore, Applicants respectfully request that the Examiner withdraw his rejection.

**VI. Claim Objections**

The Examiner objected to claims 53-60 because of the following informalities: The claims recite the phrase "one or more genetic profiles includes" in line 1. The Examiner requested that the term "includes" be amended to the singular form.

Applicants have canceled the rejected claims. As genetic profiles are not included in Applicants' new claims, the informality is absent. Therefore, Applicants respectfully request that the Examiner withdraw his objection.

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## CONCLUSION

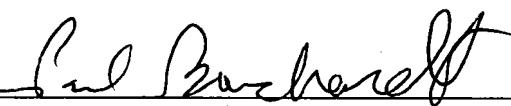
Applicants submit that this paper fully addresses the Office Action mailed February 27, 2007. Should the Examiner have any questions, the Examiner is encouraged to contact the undersigned attorney at (650) 493-9300. The Commissioner is authorized to charge any additional fees which may be required, including petition fees and extension of time fees, to Deposit Account No. 23-2415 (Docket No. 29954-701.201).

Respectfully submitted,

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Dated: July 27, 2007

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